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10/508,858	09/24/2004	Masatoshi Hotta	Q69368	8566

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SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER
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MERKLING, MATTHEW J

ART UNIT	PAPER NUMBER
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1795

MAIL DATE	DELIVERY MODE
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12/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/508,858

**Applicant(s)**

HOTTA ET AL.

**Examiner**

Matthew J. Merkling

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/24/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 6, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Christensen (US 3,041,151).

Regarding claims 1, 2 and 6, Christensen discloses a reaction apparatus comprising a heat exchanger (shell (6), tubes (21)) and a reactor (catalyst bed, (11)) with a heater (electric heater, (7), col. 4 lines 24-26)), which are enclosed in an outer casing (shell (1)),

wherein the heat exchanger has a first (top of heat exchanger as depicted in Fig. 2) end and a second end (bottom of heat exchanger as depicted in Fig. 2) whereby the first end of the heat exchanger (6, 21) being connected to the reactor (11), and the second end of the heat exchanger (6, 21) and a bottom of the outer casing 6 being fixed to each other by a flange (28, see Fig. 2), and a double piping (see Fig. 2) having an inner tube (50) and an outer tube (which is connected to outlet 51) for introducing a gas to be treated through the inner pipe (49, col. 5 lines 5-9) and discharging the treated gas through the annular space, or outer pipe (see Fig. 2, col. 5 lines 33-39), such that the gas passes

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through the heat exchanger (after entering through 49, the gas enters into heat exchanger 6,21), the reactor (after exiting the heat exchanger, the gas travels to the reactor 11) and the heat exchanger (after reactor gas travels back down to the heat exchanger 6,21) in this order during the process (see gas flow directions in Fig. 2).

Regarding limitations recited in claim 1 which are directed to a manner of operating disclosed system, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP §2114 and 2115. Further, process limitations do not have a patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states "Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim.

Regarding claims 9 and 10, Christensen discloses a method comprising passing a gas to be treated sequentially into an inner tube (49) in a double piping (see Fig. 2), a heat exchanger (shell (6), tubes (21)), a reactor (11) with a heater (7), the heat exchanger and the outer tube (51) in the double piping in this order and heating the gas to be treated by the heater before the gas to be treated is introduced into the reactor (col. 4 lines 19-29), thereby adjusting the temperature difference in the gas flow direction inside the reactor.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen (US 3,041,151) as applied to claim 1 above, and further in view of Keto et al. (US 3,732,517).

Regarding claim 3, Christensen, as discussed in claim 1 above, teaches a casing that is removable via bolts (47), but fails to teach an eyebolt fixing part for detachably engaging the outer casing to the reactor.

Keto discloses an apparatus that contains a removable fuse assembly from a casing.

Keto teaches an eyebolt (26) located at the top of the apparatus in order to facilitate separating the fuse assembly from the casing (col. 2 lines 51-53).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the eyebolt of Keto to the top of the reaction apparatus of Christensen in order to facilitate the separation of the casing from the reaction apparatus.

5. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen (US 3,041,151) as applied to claim 1 above, and further in view of Serratore et al. (US 3,278,633).

Regarding claims 4 and 5, Christensen, as discussed in claim 1 above, teaches heat exchange between the reactor and the surrounding gas (see flow direction of untreated, gas past reaction chamber) and between the gas flowing in the double piping into and out of the reaction apparatus (see flows 49 and 51). Christensen, however, fails to teach fins located in the reactor and between the inner and outer pipes.

Serratore discloses a reaction apparatus with heat exchange between the components in the reaction apparatus.

Serratore teaches fins attached to heat exchange surfaces in order to increase heat exchange efficiency (col. 3 line 74 – col. 4 line 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the fins of Serratore to the reactor and the inner and outer pipes of Christensen in order to improve the heat exchange efficiency between process components.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen (US 3,041,151) as applied to claim 6 above, and further in view of Nakamura et al. (US 3,814,171).

Regarding claim 7, Christensen, as discussed in claim 6 above, discloses a preference for decreasing the temperature of a converted exiting gas as much as possible in the interest of recovering the maximum amount of heat from the converted gas (col. 1 line 59 – col. 2 line 27). One way of doing this is to use excess heat from the converted gas to heat a boiler and produce steam (col. 1

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line 59 – col. 2 line 27). Christensen, however, fails to teach a radiating plate on the outer tube (exiting tube) of the double piping.

Nakamura also discloses an apparatus for maximizing heat transfer between two streams.

Nakamura teaches adding radiating plates to the outer surface of heat transfer tubes in order to promote heat exchange efficiency (see claim 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the radiating plates of Nakamura, to the outer surface of the exiting gas tube of Christensen in order to promote heating exchange efficiency between the exiting gas and a boiler to maximize energy recovery and produce steam from the boiler, as mentioned in Christensen.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen (US 3,041,151).

Regarding claim 8, the claimed orientation (horizontal) of the reaction apparatus does not distinguish the claimed invention over the prior art as changing the orientation of the apparatus would have been obvious to one of ordinary skill in the art to meet needs of installation space constraints. Furthermore, shifting the orientation of the apparatus does not change the operability of the apparatus and does not confer patentability (see MPEP §2144.04).

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8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen (US 3,041,151).

Regarding claim 11, Christensen discloses a preference for decreasing the temperature of a converted exiting gas as much as possible in the interest of recovering the maximum amount of heat from the converted gas (col. 1 line 59 – col. 2 line 27). Christensen, however, does not explicitly disclose the temperature difference between the incoming and exiting streams is less than 50°C.

It was well known in the art at the time of the invention that the minimization of temperature difference between the incoming and exiting streams was preferable to maximize energy efficiency, as is discussed by Christensen. Therefore, one of ordinary skill in the art at the time the invention was made would have optimized, by routine experimentation, the reaction apparatus operation variables to decrease temperature difference of the exiting and incoming streams to as little as possible (below 50°C) in order to maximize energy efficiency (In re Boesch, 617 F. 2d. 272,205 USPQ 215 (CCPA 1980)). Since it has been held that where general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (In re Aller, 105 USPQ 223).



### ***Response to Arguments***

#### ***Claim Objections***

9. The claim objections have been withdrawn in light of the amendments.

#### ***35 USC §112 Rejections***

10. The rejections under 35 USC §112 have been withdrawn in light of the amendments.

#### ***35 USC §102 Prior Art Rejections***

11. Applicant's arguments filed 10/24/07 regarding the prior art rejections under 35 USC §102(b) have been fully considered but they are not persuasive.

12. Applicant argues that Christensen does not teach a double piping for introducing a gas to be treated and discharging the treated gas. The examiner respectfully disagrees. As set forth in the previous office action (mailed 7/24/07), Christensen clearly discloses a double pipe configuration as depicted in Figure 2 where incoming gas to be treated enters through 49 (which is the same gas which enters through 4, only at a different temperature, as discussed in col. 5 lines 5-9) and treated gas exits through 51.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Merklings whose telephone number is (571) 272-9813. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexa Neckel can be reached on (571) 272-1446. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*MM*

MJM

*Alexa D. Neckel*  
**ALEXA D. NECKEL**  
**SUPERVISORY PATENT EXAMINER**